

Appl. No.: 09/977,895
Filed: October 15, 2001
Response dated 10/06/2006

REMARKS

This response is submitted with a request for a three month extension, a Request for Continued Examination and appropriate fees in reply to the Office Action dated April 7, 2006. Claims 1-5 currently stand rejected. Claims 1 and 2 have been amended and newly added claims 11-13 have been added to further define patentable aspects of the invention. No new matter has been added by the amendment

In light of the remarks presented below, Applicants respectfully request reconsideration and allowance of all now-pending claims of the present application.

Claim Rejections Under 35 U.S.C. §112

Claims 1-5 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action asserts that the claim does not set forth any steps involved in the method. Applicants have amended the preamble of independent claim 1 such that the claim now sets forth steps involved in the method.

Claim 2 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for containing the phrase "such as". Claim 2 has been amended to eliminate the objectionable phrase.

Accordingly, Applicants respectfully submit that the rejections of claims 1-5 under 35 U.S.C. §112, second paragraph, are overcome.

Claim Rejections

Claims 1-4 currently stand rejected under 35 U.S.C. §102(e), as being anticipated by Wiser et al. (U.S. Patent No. 6,385,596, hereinafter "Wiser"). Claim 5 currently stands rejected under 35 U.S.C. §103(a) as being unpatentable over Wiser. Applicants respectfully traverse.

As previously stated, independent claim 1 recites, *inter alia*, producing an advertising digital music file by performing one of either **deteriorating or damaging a sound quality of an original music file** of a cooperating record corporation. In other words, sound quality of an original music file is either deteriorated or damaged to produce an advertising digital music file.

Wiser is directed to a secure online music distribution system (col. 3, lines 5-10). In order to provide such security, Wiser discloses that an encrypted version of a song, which is a high fidelity audio image, is provided to be purchased (col. 3, lines 54-55). For publicity purposes, Wiser also discloses that lower quality "clips" are also available for free to assist the customer in deciding whether to buy the song (col. 3, lines 58-61). However, contrary to the claimed invention, the clips are selected portions or the entire song that are **recorded with lesser quality**. At col. 12, lines 12-15, Wiser discloses that a media data file (200) may include different audio images (208), each having different quality levels. However, there is no teaching or suggestion in the cited passage, or any portion of Wiser, that the sound quality of an original music file is either deteriorated or damaged to produce an advertising digital music file as claimed in the claimed invention. Rather, according to Wiser, music files are **recorded** at different quality levels.

As further evidence of this, Wiser discloses an encrypted and un-encrypted version of a song (col. 3, lines 51-52). The encrypted version is a high fidelity audio image of a song (col. 3, lines 54-55). Meanwhile the un-encrypted version is a version of the song **recorded** with lesser quality (col. 3, lines 55-58). As is well known, the song may be **recorded** to form a digital music file. Accordingly, Wiser discloses the recording of two digital music files. One is recorded as a high fidelity audio image of the song, while the other is recorded with lesser quality. Thus, it is clear that Wiser fails to teach or suggest **deteriorating or damaging a sound quality of an original music file** as recited in independent claim 1. To the contrary, the un-encrypted version

of Wiser (i.e., the version recorded with lesser quality) is recorded as an original music file, but recorded to have lesser quality.

Accordingly, Wiser fails to teach or suggest producing an advertising digital music file by performing one of either **deteriorating or damaging a sound quality of an original music file** of a cooperating record corporation as claimed in independent claim 1. Thus, Wiser fails to anticipate or render independent claim 1 obvious. Claims 2-5 depend directly from independent claim 1 and thus include all the recitations of independent claim 1. Therefore, dependent claims 2-5 are patentable for at least those reasons given above for independent claim 1. Accordingly, Applicants respectfully submit that the rejections of claims 1-5 are overcome.

Newly Added Claims

Applicants have added new claims 11-13 to more particularly define aspects of the present application. The new claims include no new matter and are fully supported by the specification and the drawings of the present application.

Applicants note that new claim 11 is similar to the combination of independent claim 1 and dependent claim 5, which the Office Action asserts is obvious in view of Wiser. Applicants respectfully disagree. Specifically, the Office Action asserts that since Wiser discloses different methods of deteriorating the sound quality of original music, it would have been obvious to include in Wiser, the method recited in the claimed invention. However, this assertion fails to establish *prima facie* obviousness since, at the very least, the assertion fails to provide any motivation to alter Wiser to achieve the claimed invention.

Additionally, Applicants note that new claims 12 and 13 contain similar subject matter to that of the combination of independent claim 1 and dependent claim 2, each of which the Office Action asserts is anticipated by Wiser (although no citation is provided with respect to the subject matter of claim 2). However, Applicants respectfully assert that Wiser fails to teach or suggest the features of independent claim 12 and dependent claims 2 and 13. As such, if the rejection is to be maintained, Applicants respectfully request that an explanation of how Wiser anticipates such claims be included in the next Office communication.

Accordingly, it is believed that the new claims are in condition for allowance.

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CONCLUSION

In view of the amendments and the remarks presented above, it is respectfully submitted that all of the claims are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested in due course. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application. It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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